REMARKS

The Official Action dated January 28, 2003, has been carefully considered. Accordingly, the changes and remarks presented herewith are believed sufficient to place the present invention in condition for allowance. Reconsideration is respectfully requested.

Claims 1, 11, 12 and 15 have been amended. Support for the amendment may be found, for example, on page 3, lines 15-30 of the specification. Claims 20-25 have been added. Support for the new claims may be found, for example, on page 12, lines 1-20. Attached hereto is **"Version with Markings to Show Changes Made,"** showing the changes made to the claims by the current amendment. It is believed that these changes do not involve any introduction of new matter, whereby entry is believed to be in order and is respectfully requested.

In the Official Action, the Examiner rejected claims 15-17 under 35 U.S.C. § 102(b) as being anticipated by Colbert et al. (U.S. Patent No. 5,699,494). The Examiner asserted that Colbert et al. teach a method for diagnosing a printer, including the steps of obtaining a stand-alone printer, establishing a communication link between the stand-alone printer and a computer, transmitting instructions over the communication link from the computer to the stand-alone printer and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions. However, as will be set forth in detail below, it is submitted that the methods for diagnosing a stand-alone printer set forth by claims 15-17 are not anticipated by Colbert et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F3d 1376, 1383, 58 U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010

(Fed. Cir. 1991). Further, the reference must describe the Applicant's claimed invention sufficiently to place a person of ordinary skill in the field of the invention in possession of it. *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986), *cert denied*, 482 U.S. 909 (1987); *In re Coker*, 463 F.2d 1344, 1348, 175 U.S.P.Q. 26, 29 (CCPA 1972). Among other reasons, as every element and limitation of claim 15, as arranged therein, cannot be found in Colbert et al., Applicants respectfully traverse the rejection of claim 15, and those claims that depend therefrom, and request reconsideration.

Claim 15, from which claims 16 and 17 depend, is directed towards a method for diagnosing a stand-alone printer. The method includes the steps of establishing a communication link between the stand-alone printer and a computer; receiving instructions from the computer at the stand-alone printer via the communication link; and diagnosing one or more functions of the stand-alone printer in accordance with the received instructions. By the present amendment, it has been further clarified that the stand-alone printer is capable of processing and printing digital files, acquired by an external device, independent of an external host device.

Colbert et al., on the other hand, discloses a remote replication of an operator panel of conventional printer on a host computer to which the printer is connected (either locally or by way of a network). The host computer is provided with access to a visual and functional replica of the operator panel of the printer, such that the user of the host computer may view the replica at the site of the host computer. According to Colbert et al., a user of the host computer can, for example, view and use an operator panel of a remote printer that is either located where it is not readily physically accessible or is obscured from the view of a user of a given host.

Among other limitations, claim 15 requires, for example, diagnosing one or more functions of a "stand-alone printer" in accordance with instructions received at the stand-alone printer via a communication link between the stand-alone printer and a computer. Colbert et al. simply fails to teach or suggest anything with respect to such a stand-alone printer. The Examiner asserted in the rejection that the printer 16 in Fig. 1 of Colbert et al. is a stand-alone printer. However, Applicants find no teaching or suggestion that the conventional printer 16 in Fig. 1 is a stand-alone printer as required by claim 15. For example, as further clarified with the present amendment, a "stand-alone printer" is a printer capable of processing and printing digital files, acquired by an external device, independent of an external host device.

In direct contrast, the remote printer 16 of Colbert et al. appears to be dependent on an external host computer 11 to process digital files (e.g., it uses a printer driver 55 running within an operating environment running on host computer 11 to transcribe a print job into PostScript format that can be interpreted by the printer 16). In fact, since Colbert et al. is directed to allowing a user of an external host computer to view and use an operator panel of a non-accessible or obscured remote printer, modifying such a non-accessible or obscured printer to make it stand-alone would further seem to be counter intuitive. Moreover, it may be worth pointing out that these same arguments were made by the Applicants in their Appeal Brief, but no response to the same was found in the present Office Action.

Finding no teaching or suggestion in Colbert et al. of diagnosing a "stand-alone printer", Colbert et al. fail to teach or suggest the methods for diagnosing a stand-alone printer, as currently defined by claims 15-17. Therefore, Colbert et al. does not anticipate the presently claimed invention. Whereby, the rejection has been overcome and reconsideration is respectfully requested.

In addition to being allowable as being based on an allowable independent claim, claims 16 and 17, which depend on claim 15, include additional limitations which are not found in Colbert et al. For example, claim 16 requires that the received instructions comprise content to be presented on a display of the stand-alone printer. Although the Examiner cites to a portion of Colbert et al. (col. 3, lines 65-67; col. 4, lines 1-5) that purportedly teaches this limitation, further examination of these portions shows that what is being discussed is merely what content is being displayed. There is simply no teaching with respect to such content being received at the printer in the form of instructions. In fact, further reference to Colbert et al. appears to show that it teaches that the printer 16, rather than host computer 11, determines content to be presented (see col. 24, lines 18-27), and teaches that this is significant (e.g., because it provides a true response of printer 16 to control actions initiated through the replica). Accordingly, if anything, Colbert et al. teaches replicating on a host computer content already presented on the display of a remote printer.

Meanwhile, claim 17 requires processing user inputs to the stand-alone printer by the computer. One advantage to such a method could include allowing the diagnostic functionality to be added without using much of the resources of a stand-alone printer. Although the Examiner cites to column 13, lines 15-35, and column 10, lines 1-40, as purportedly supporting this position, the discussion of flags in column 13 does not appear to have anything to do with user inputs (it appears to deal with printer conditions), while the discussion in column 10 merely describes what the printer can do. Neither have anything to do with a computer processing user inputs to a stand-alone printer. In fact, Colbert et al., appears to teach just the opposite (e.g., in column 23, lines 65-67, it appears to teach that a printer state manager 140 operating via controller 72 of printer 16 processes commands corresponding to user inputs to the printer).

Accordingly, as Colbert et al. fails to teach every limitation of claims 16 and 17, it fails to anticipate those claims. Therefore, the rejection of claims 16 and 17 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claims 1-6, 9 and 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Satomi et al.(U.S. Patent No. 4,759,053) in view of Batten et al. (U.S. Patent No. 6,417,937). The Examiner asserted that Satomi et al. teach a printer configuration comprising: a) a computer readable medium comprising data; b) a computer having access to the data on the computer readable medium; c) a communication link connected to the computer; d) a printer connected to the communication link and in communication with the computer, the printer having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism on the printer. The Examiner noted that Satomi et al. fail to teach or disclose that the printer is a photoprinter.

Apparently because of the deficiencies of Satomi et al., the Examiner asserted that Batten et al. teach a facsimile equipment/machine that inherently prints an image of a photograph by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signals suitable for storing, displaying, processing by a computer, transmitting and printing. (Note: Applicants believe the Examiner mistakenly cited Yoo in place of Batten et al. in the comment section. As such, all remarks are towards Satomi et al. in view of Batten at al.) The Examiner asserted it would have been obvious to have modified the facsimile equipment of Satomi et al. to include reading a photograph, transmitting the read photograph to the computer, and receiving the transmitted read photograph from the computer for printing.

However, as will be set forth in detail below, it is submitted that the printer configurations and methods for accessing digital photographs defined by claims 1-6, 9 and

11-13 are non-obvious and patentably distinguishable from Satomi et al. in view of Batten et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). Moreover, in order for references to be relied upon to support a rejection under 35 U.S.C. § 103 they must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *Glaxo Inc. v. Novopharm Ltd.*, 34 U.S.P.Q.2d, 1565 (Fed. Cir. 1995); *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Neither Satomi et al. nor Batten et al., whether alone or independently, satisfy these requirements.

As defined by claim 1, the present invention relates to a printer configuration. The printer configuration comprises: a computer readable medium comprising data; a computer having access to the data on the computer readable medium; and a photoprinter in communication with the computer via a communication link, the photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism. As clarified with the present amendment, a photoprinter is a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

As defined by claim 11, the present invention relates to a printer configuration. The printer configuration comprises: a computer having a plurality of digital photographs on a computer readable medium; and a photoprinter communicating with the computer via a communication link, the photoprinter having means for accessing the digital photographs. As clarified with the present amendment, a photoprinter is a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

As defined by claim 12, the present invention relates to a method of accessing digital photographs on a computer. The method comprises: establishing a communication link between a photoprinter and the computer; receiving a request at the photoprinter from a user; and accessing the digital photographs with the photoprinter in response to the request. As clarified with the present amendment, a photoprinter is a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

Meanwhile, Satomi et al. disclose a facsimile/character communication system capable of transmitting or receiving character data through a host computer intermediately storing the character or picture data. Batten et al. discloses an automatic document feeder and active transparency adapter for a scanner. As noted by the Examiner, Satomi et al. fail to teach, disclose or suggest a photoprinter.

Applicants find no teaching or suggestion in Batten et al. of a photoprinter, as defined and required by claims 1, 11 and 12. The Examiner asserted that Batten et al. teach a facsimile equipment/machine that inherently prints an image of a photograph. However, as defined by the claims 1, 11 and 12, a "photoprinter" is a printer capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device. Neither Batten et al. nor Satomi et al. disclose or teach a printer capable of such functionality.

In view of the failure of Satomi et al. and Batten et al., alone or in combination, to teach, disclose or suggest a photoprinter as defined by claims 1, 11 and 12, Satomi et al. and Batten et al. do not render the presently claimed printer configurations and methods obvious. It is therefore submitted that the presently claimed printer configurations and methods are non-obvious over and patentably distinguishable from Satomi et al. in view of Batten et al.,

whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Satomi et al. in view of Batten et al. and further in view of Foth (U.S. Patent No. 6,473,498). The Examiner noted that Satomi et al. do not teach wherein the computer is connected locally to the photoprinter. The Examiner asserted that Foth teaches connecting a computer to a facsimile machine by using an RS232 cable. The Examiner asserted that it would have been obvious to a person of ordinary skill in the art to modify Satomi et al./Yoo's photoprinter to include the computer being locally connected to the facsimile machine of the photoprinter. (Note: Applicants believe that the Examiner mistakenly cited Yoo in place of Batten et al. As such, the remarks will be based on Satomi et al., Batten et al. and Foth.) However, as will be set forth in detail below, it is submitted that the printer configuration of claim 7 is non-obvious and patentably distinguishable over the teachings of Satomi et al. in view of Batten et al. and in further view of Foth.

As defined by claim 7, the present invention is directed towards a printer configuration of claim 1, wherein the computer is connected locally to the photoprinter. The teachings of Satomi et al. in view of Batten et al. are discussed above. The deficiencies of Satomi et al. in view of Batten et al. are not overcome with the combination of Foth. Moreover, Foth alone or in combination with Satomi et al. and Batten et al., fail to teach or suggest a printer configuration wherein the computer is connected locally to the photoprinter.

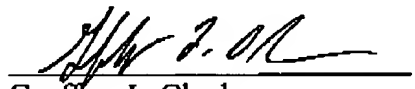
Foth discloses a system for utilizing a single incoming/outgoing line to transmit and receive data through a variety of devices. While Foth discloses that a computer may be connected to a facsimile machine, Applicants find no teaching or suggestion by Foth of a photoprinter, as defined and required by claims 1, 11 and 12. It is therefore submitted that the presently claimed printer configuration is non-obvious over and patentably

distinguishable from Satomi et al. in view of Batten et al. and further in view of Foth, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

By the present amendment, Applicants have also added new claims 20-25. Applicants believe that neither Colbert et al., Satomi et al, Batten et al., nor Foth, whether alone or in combination, teach or suggest the printer configurations and methods of claims 20-25. An indication of the allowability of new claims 20-25 is therefore respectfully requested.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§102 and 103 and places the present invention in condition for allowance. Reconsideration and an early allowance are respectfully requested.

Respectfully submitted,



Geoffrey L. Oberhaus
Registration No. 42,955
Dinsmore & Shohl LLP
1900 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202
(513) 977-8623

896252

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claims 1, 11, 12 and15 have been amended as follows:

--1. A printer configuration, comprising:

a) a computer readable medium comprising data;

b) a computer having access to the data on the computer readable medium; and

c) [a communication link connected to the computer;

d)] a photoprinter [connected to the communication link and] in communication with the computer via a communication link, the photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism [on the photoprinter],

wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device .--

--11. A printer configuration, comprising:

a) a computer having a plurality of digital photographs on a computer readable medium; and

b) [a communication link connected to the computer; and

c)] a photoprinter connected to the computer via [the] a communication link, the photoprinter having means for accessing the digital photographs,

wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.--

--12. A method for accessing digital photographs on a computer, the method comprising the steps of:

a) [placing one or more digital photographs on a computer;

b)] establishing a communication link between a photoprinter and the computer;

[c]b) [inputting] receiving a request [to] at the photoprinter [by]from a user; and

[d]c) accessing the digital photographs [by] with the photoprinter in response to the request,

wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.--

15. (Amended) A method for diagnosing a stand-alone printer, the method comprising the steps of:

a) [obtaining a stand-alone printer;

b)] establishing a communication link between the stand-alone printer and a computer; [and]

[c]b) [transmitting] receiving instructions from the computer at the photoprinter via [over] the communication link [from the computer to the stand-alone printer]; and

[d]c) diagnosing one or more functions of the stand-alone printer in accordance with the [transmitted] received instructions

, wherein the stand-alone printer is capable of processing and printing digital files independent of an external host device.

The following new claims have been added:

Please add the following new claims:

--20. (New) The method of claim 15, further comprising presenting a menu on a display of the stand-alone printer, wherein the one or more functions are diagnosed after a diagnostic mode is chosen from the menu.--

--21. (New) The method of claim 15, wherein the computer does not process the digital files.--

--22. (New) The method of claim 15, wherein the step of diagnosing one or more functions comprises interacting with a user of the stand-alone printer to determine if the one or more functions performs correctly.--

--23. (New) The method of claim 22, wherein the step of interacting with a user further comprises displaying on a display of the stand-alone printer a suggestion for fixing a problem diagnosed with respect to the one or more functions.--

--24. (New) The method of claim 15, wherein the stand-alone printer is incapable of diagnosing the one or more functions without receiving the instructions.--

--25. (New) The method of claim 15, wherein the computer is capable of:

a) writing to a display of the stand-alone printer;

b) reading an input from a selection mechanism of the stand-alone printer, wherein a user provides the input in response to the display;

c) reading memory associated with the stand-alone printer; and

d) sending data to a print controller of the stand-alone printer.--